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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,438	09/28/2000	Todd O. Burger	C1068/7005	9912

7590

06/01/2004

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Boston, MA 02210

EXAMINER
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ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/675,438

Applicant(s)

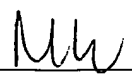
BURGER ET AL.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-17, 56-59, 79-85, 102-105 and 132-137 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-17, 56-59, 79-85, 102-105 and 132-137 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12 and 13.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. This Office action is in response to Applicant's amendment, filed on 12/31/2003.
2. Claims 1-13, 18-55, 60-78, 87-101, and 106-131 are cancelled, and claims 14-17, 56-59, 79-85, 102-105 and 132-137 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:  
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 14-17, 56-59, 79-85, 102-105, and 132-137 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Wang (U.S. pat. No. 6,282,656) and Smith (U.S. pat. No. 6,012,636) in view of Grant et al. (U.S. Pat. No. 6,095,416).

**As per claims 14-17, 56, 58, 59, 79, 82, 86, 102-105, and 132-137** Wang substantially discloses a method/apparatus for completing a transaction request pertaining to an electronic transaction conducted over an electronic network having a server and a requesting device (which is seen to read as Applicant's claimed invention wherein it is stated that an apparatus), comprising:  
a housing (see., figs 1 and 2, col 2, lines 3-29, item 102);

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a user authenticator, supported by the housing, that authenticates an identity of a user (see., figs 1 and 2, item 200, col 4, lines 46-67);

at least one memory, supported by the housing, that stores transaction information for at least first and second media (see., figs 1 and 2, items 104, 202, and 200, col 2, lines 3-67, col 4, lines 46-67, col 5, lines 1-25);

at least one output, supported by the housing, that releases at least a portion of the transaction information to a point-of-sale (POS) terminal after the user authenticator has authenticated the identity of the user (see., figs 1 and 2, col 1, lines 17-39, col 3, lines 21-35, specifically wherein it is stated that the method includes receiving from the server at the requesting device a transaction program, which includes an executable portion). It

is to be noted that Wang fails to explicitly disclose a first information and a second information that identify a first media and a second media. However, Smith discloses a first memory and a second memory ( or first and second information) for storing data unique to a user and for storing provider data see., abstract, lines 2-12, col 4, lines 33-51, Smith further discloses the limitation of displaying a visual indication to the user see., abstract, lines 8-12, specifically wherein it is stated scanner for imaging (or displaying) of a fingerprint for comparison with the digital representation of the user's fingerprint for identification of the proper user). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Wang by including the limitations detailed above as taught by Smith because such modification would verify that the individual is the person authorized for the subject use, access or right.

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Wang and Smith fail to explicitly disclose Applicant's newly added limitation wherein said embedded identification code of the apparatus that is unique to the apparatus to authenticate the identity of the apparatus. Grant discloses an authorization card, such as credit card, has a security feature. The card remains in the disabled state until a PIN code (or identification code) is entered on a keypad provided on the card. Once the card is enabled, access to the confidential information is permitted for a predetermined period of time, after the card reverts back to the default disabled state (see., abstract, col 2, lines 11-67, col 3, lines 46-67). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Wang and Smith by including the limitations detailed above as taught by Grant because this would prevent unauthorized access of the apparatus.

**As per claim 57 Wang** discloses the claimed limitations wherein the user authenticator comprises means for authenticating the identity of the user by analyzing a bio-metric feature of the user (see., col 15, lines 42-55, specifically wherein said user's facial image, finger print and so on).

**As per claim 80, 81, 83, 84 and 85 Wang** discloses the claimed limitations of simulating a magnetic stripe readable by a point-of-sale terminal (see., col 15, lines 30-40, specifically credit card, and credit card reader have magnetic stripe or bar code).

RESPONSE TO ARGUMENTS

5. Applicant's arguments filed on 12/31/2003 have been fully considered but they are moot in view of new ground (s) of rejection. Necessitated by IDS filed on 10/06/2003.

### ***Conclusion***

6. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 10/06/2003 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Pierre Eddy Elisca

Primary patent Examiner

May 26, 2004